

Remarks

The § 103 (a) Rejections of Claims 1, 2, and 5-11

The Examiner continued the rejection of Claims 1, 2, and 5-11 as unpatentable under 35 U.S.C. § 103 (a) as obvious over U.S. Patent No. 6,650,703 to Schwarzmenn, et al. ("Schwarzmenn" or "the '703 patent") in view of PCT publication WO 98/01999 to Clinch ("Clinch" or "the Clinch publication"). Applicant has amended Claim 1 to claim the steps of the claimed method in order and respectfully traverses of these rejections and requests reconsideration.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In addition, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant respectfully submits that the combined Schwarzmenn and Clinch references fail to establish a *prima facie* case of obviousness because they fail to disclose the all the limitations of the rejected claims.

As stated in the previous Reply of November 11, 2004, Applicant respectfully submits that the chief distinction between the method claimed in Claim 1 and that disclosed by the combined Schwarzmenn and Clinch references is that the claimed method claims a method of outputting a series of complete joined images to an output device such as a monitor, while the cited references both teach the outputting of a series of partial images. By outputting is meant that each of the series of successive images delivered by the method of Claim 1 to the output device, such as a monitor, is a complete image. As claimed in Step h, the method claims the step of generating an assembled and coded complete image in an image assembler which is then outputted as a complete image (step i.) This is explained in paragraph 0028 describing the receipt of coded

complete or partial images from a coder 21 and their subsequent joining to form a new complete image 45₂ that is output to an output medium such as a monitor.

The Examiner states that Schwarzmenn also discloses the claimed transferring step. However, Applicant submits that Schwarzmenn discloses transferring of partial images to an output device while, as discussed above, Applicant claims a method in which complete images are transferred to an output device. The Examiner points to col. 4, lines 4-44 in Schwarzmenn as disclosing the image transferring step. However, lines 8-11 state, "...in several steps in each case only the fresh image areas entering into the field of view 25, which represent those areas of the current visual field 45a, which do not overlap with the visual field 45b of the preceding steps are transferred. Since the surface newly arriving is clearly smaller than the total surface of the microscope field of view image areas 25 again in each case, a corresponding reduction of quantity of image data to be transferred results. At the observation station, the transmitted image areas 25 are then joined at the existing image, which was first correspondingly shifted as shown by the displacement arrow 26 in FIG.3." (Emphasis added.) It can be seen that while all the images transferred in the Schwarzmenn method are partial images, Applicant's claimed method differs from that of the '703 patent in that all the images transferred by Applicant's claimed method are complete images. Neither Schwarzmenn nor Clinch disclose or suggest the receipt of complete images by an output device. Therefore, the combined Schwarzmenn and Clinch references fail to establish a *prima facie* case to render Claim 1 unpatentable under §103 (a).

Applicant has amended Claim 1 to claim the steps of the method in order. This distinguishes the claimed method from the steps disclosed in Schwarzmenn as the complete image is formed and outputted to a buffer memory (step i) whereas a complete image is formed only at the observation station in Schwarzmenn. Schwarzmenn does not discuss or teach or suggest the formation of any complete image before the observation station. For this additional reason, the combined Schwarzmenn and Clinch references fail to render Claim obvious under § 103 (a).

Moreover, use of the claimed method confers an unexpected advantage over the method disclosed by the combined references. Specifically, the method disclosed in

Schwarzmann requires that consecutive images have small overlap areas that are use to perform a correlation analysis to decide exact projection of the viewed image. (See Schwarzmann col. 9, lines 27-33.) In contrast, because the successive images generated using the method of Claim 1 are complete images made by joining offset portions of one image with the preceding complete image, the transfer of complete joined images to the output device, as claimed Claim 1, eliminates the need for correlation analysis projections and results in more accurate image projections.

Applicant takes note of the statement that the Examiner understands the difference being drawn by the Applicant, but respectfully traverses the Examiner's statement that the "interpretation of the prior art" made by Applicant leads to the same result. It is well settled that in process claims, the result or final product produced by a claimed process does not in and of itself affect the patentability of that claimed process. Such a rationale leads to the use of impermissible hindsight in that if the result is known, a method used to achieve that result must be obvious. Therefore, the fact that the processes disclosed in Schwarzmann and Clinch may lead to the production of a series of images for a microscope view screen does not of necessity establish a *prima facie* case to render Claim 1 obvious.

For the above reasons, including the Examiner's statement acknowledging understanding of the differences drawn by Applicant, it can be seen that the combined Schwarzman and Clinch references fail to establish a *prima facie* case to render amended Claim 1 obvious under § 103 (a).

"If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Claims 2, 5 and 6 depend from Claim 1 and thus incorporate all the limitations of that claim. Because, as discussed above, the combined Schwarzmann and Clinch patents fail to render obvious Claim 1, they also fail to render obvious Claims 2, 5, and 6. Applicant respectfully requests the removal of the rejections of Claims 2, 5, and 6 and passage to allowance of those claims.

Applicant has cancelled Claim 8 and amended independent Claim 7 by combining the limitations of Claim 8 with Claim 7. In addition, Applicant has amended Claim 9 to depend from amended Claim 7. Claim 7 claims an arrangement for coding live images in microscopy. Applicant respectfully submits that the combined Schwarzmans and Clinch references fail to establish a *prima facie* case of obviousness against amended Claim 7 in that neither reference discloses an arrangement in which both coded partial images and coded complete images can be output from an image assembler. As discussed above, the component assembly in Schwarzmans only discloses the combining of complete images at an observation point as opposed to the output of complete images by the image assembler. In other words, Claim 7 claims an arrangement that practices the method claimed in Claim 1 which as seen above is distinguishable from the combined Schwarzmans and Clinch disclosures. For this reason, Applicant respectfully submits that the combined Schwarzmans and Clinch references fail to render Claims 7 obvious under §103 (a). Applicant respectfully requests reconsideration.

“If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Claims 9-11 depend from Claim 7 and thus incorporate all the limitations of that claim. Because, as discussed above, the combined Schwarzmans and Clinch patents fail to render obvious Claim 7, they also fail to render obvious Claims 9-11. Applicant respectfully requests the removal of the rejections of Claims 9-11 and passage to allowance of those claims.

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Conclusion

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,



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